

REMARKS

Claims 75-91 are indicated by the Office Action to recite allowable subject matter. The undersigned spoke with Examiner Lee on September 1, 2004 who indicated that the recitation of allowable subject matter is in error and claims 75-82, 85 and 91 are allowable consistent with the claims which were not rejected as set forth in the Office Action. Applicant appreciate the recognition of patentable subject matter in the present application.

Applicant hereby cancels claim 71. Accordingly, claims 69-70 and 72-93 are pending in the present application.

Claims 69-74, 83-84, and 86-89 stand rejected under 35 U.S.C. 103(a) for obviousness over U.S. Patent No. 5,552,790 to Gunnarsson in view of U.S. Patent No. 5,448,110 to Tuttle et al. Claim 92 stands rejected under 35 U.S.C. 103(a) for obviousness over Gunnarsson in view of Tuttle et al. and further in view of U.S. Patent No. 5,859,587 to Alicot et al. Claim 90 and 93 stand rejected under 35 U.S.C. 103(a) for obviousness over Tuttle et al. in view of Gunnarsson and further in view of U.S. Patent No. 5,826,328 to Brady et al. and U.S. Patent No. 5,252,783 to Baird.

Applicant respectfully traverses the rejections and urges allowance of the present application.

Referring to claim 69, Applicant has amended claim 69 to include the limitations of previously pending claim 71. Claim 69 recites the integrated circuit includes a *modulator configured to communicate using backscatter communications*. The Office relies upon the teachings of col. 6, lines 27-49 of Gunnarson as allegedly disclosing the claimed

backscatter communications. The reliance is misplaced inasmuch as Gunnarson fails to disclose or suggest any backscatter communications.

In particular, the identified teachings of col. 6 of Gunnarson merely disclose that if a response is appropriate, the control logic 15 reads transmit data from memory 16 and enables transmitter 14 for sending the transmit data as a second radio signal on antenna 4, 5. Dipole antenna 4, 5 matches the medium to the receiver and to the transmitter for improved receiver sensitivity and reduced transmission losses. However, *the identified teachings fail to disclose or suggest any **backscatter communications** by the transmitter.* Gunnarson is void of any disclosure or suggestion of backscatter communications as positively recited in claim 69 and claim 69 is allowable for at least this reason.

More specifically, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed.).

Even if Gunnarson is modified as alleged in the Action, the modification fails to disclose or suggest positively recited limitations of claim 69. The Office has failed to establish a *prima facie* rejection of claim 69 and Applicant respectfully requests allowance of claim 69 in the next Action.

Applicant has electronically searched Gunnarson and have failed to uncover any backscatter teachings. In the event that a rejection of claim 69 is maintained with respect to the prior art, or a new rejection made, Applicant respectfully requests identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R. §1.104(c)(2). In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicant, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicant respectfully requests clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if claim 69 is not found to be allowable.

The claims which depend from independent claim 69 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to claim 72, such claim now recites the power source electrically connected with the ground plane. Any alleged capacitive coupling of Gunnarson as relied upon by the Office on pages 3-4 of the Action fail to disclose or suggest the claimed power source electrically connected with the ground plane.

Limitations of claim 72 are not disclosed nor suggested by the prior art and claim 72 is allowable for at least this reason.

Referring to claim 83, the Examiner relies upon the teachings of Tuttle to modify Gunnarson in support of the obvious rejection of claim 83. However, as mentioned above, a proper 103 rejection requires motivation to combine the reference teachings. There is no motivation present to support the combination of references for the 103 rejection of claim 83. Further, the Office fails to identify any motivation to modify the Gunnarson teachings.

An alleged motivational rationale is identified on page 3 of the Action regarding the encapsulated limitations of claim 69. However, there is no motivation to modify the teachings of Gunnarson in support of the 103 rejection of claim 83. In particular, claim 83 recites ***printing the antenna over the ground plane***. Gunnarson is void of any teaching or suggestion of printing the antenna. Applicant has electronically searched Gunnarson and have failed to uncover any "printing" teachings. There is no motivation to modify Gunnarson as disclosed by Tuttle in an effort to arrive at the method defined in claim 83. Numerous other alternatives exist besides the positively-recited limitation of *printing the antenna*. In the absence of any motivational rationale provided by the Office, it is clear that the only motivation results from improper reliance upon Applicant's disclosure. *However, the motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination.* See, e.g., *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re*

Mills, 16 USPQ2d 1430 (Fed. Cir. 1990). No motivation has been presented by the Office in support of the rejection of claim 83. The Office has failed to establish a prima facie rejection of claim 83 for at least this reason. Applicant requests allowance of claim 83 in the next Action for at least the above-mentioned compelling reason. If claim 83 is not allowed, Applicant respectfully requests issuance of a non-final Action which presents rationale in support of the 103 rejection so Applicant may appropriately respond during the prosecution of this application.

The claims which depend from independent claim 83 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 88, the method recites *providing an encapsulant to form the device comprising a substantially void-free mass*. On page 5 of the Action, it is stated that total encapsulation over the whole device housing *inherently* results in a substantially void free mass. Applicant disagrees and asserts the reliance upon inherency is misplaced. Applicant asserts that in relying upon the theory of inherency, *the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art*. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). No basis in fact and/or technical reasoning has been provided and in fact none exists. Numerous other alternatives apart from providing the encapsulant to form the device comprising a void-free mass exist. There is no evidence of record that a device which is not void-free

would not operate as disclosed by the prior art. Other alternatives exist apart from Applicant's claimed *void-free mass* and mere encapsulation does not disclose a void-free mass. In accordance with the above-authority, the Office's reliance upon inherency is misplaced and the rejection of claim 88 is improper for at least this reason.

Claim 88 recited limitations which are not disclosed nor suggested by the prior art. In accordance with the CFR, Applicant respectfully requests issuance of a non-final Action to identify teachings which disclose the claimed void-free mass so Applicant may appropriately respond.

The claims which depend from independent claim 88 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to claim 89, the prior art whether taken individually or combined, fails to disclose or suggest the claimed **grounding of the conductive layer**. *The Examiner has identified no teachings in support of the allegation on page 5 of the Action that the ground plane is for electrical ground.* The prior art is void of any teaching or suggestion of grounding a ground plane or any structure which may be fairly considered to disclose or suggest the grounding of the conductive layer recited in claim 89.

The art is devoid of disclosing numerous limitations of Applicant's claims at least some of which have been identified above. The knowledge of the Examiner has been relied upon in formulation of the rejection of claim 89 inasmuch as the prior art is devoid of any disclosure or suggestion of the limitations of claim 89. The undersigned hereby

traverses and seasonably challenges the reliance upon the personal knowledge of the Examiner pursuant to MPEP §2144.03 (8th ed.), and *requests the Examiner cite a reference in support of his or her position or submit an affidavit in a non-final Action so Applicant may appropriately respond. Assertions of technical facts in areas of esoteric technology **must always be supported by citation of some reference work** and allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported. *In re Ahlert*, 424 F.2d 1088, 165 USPQ 418, 420-421 (CCPA 1970). The Examiner is reminded that the facts constituting the state of the art are normally subject to the possibility of rationale disagreement among reasonable men and are not amenable to the taking of judicial notice. See *In re Eynde*, 480F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973). If claim 89 is not allowed, Applicant hereby requests identification of prior art which discloses claimed limitations not found in the references of record or the submission of an affidavit in support of any rejection of the claims in **a non-final Action**.*

Applicant filed a Supplemental Information Disclosure Statement on August 3, 2004 prior to the mailing of the Office Action. Applicant submits a courtesy copy of the IDS herewith. Applicant respectfully requests consideration of the references cited on the form PTO-1449 and return of the initialed form to Applicant.

With respect to the refusal of the Examiner to initial properly submitted references in Information Disclosure Statement filed November 20, 2001, Applicants request consideration of the references of which Micron Technology is the Assignee with respect


to any double patenting issues (References AK (1449 sheet 1), AA, AB, AK (1449 sheet 2) and AL of the IDS mailed November 20, 2004).

Applicant respectfully requests allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated: 12/27/04

By: 
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